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OFFICE OF PETITIONS

In re Application of
Ellsworth et al.
Application No. 10/629,825
Filed: July 30, 2003
Attorney Docket No. 70869-0113US

Decision on Petition

This is a decision on the petition filed September 20, 2005, which is being treated as a petition under 37 CFR 1.78(a)(6) to accept an unintentionally delayed priority claim set forth in the concurrently filed amendment.

The petition is **dismissed**.

The application was filed on July 30, 2003.

The application was not filed as a national stage of any PCT application.

The specification did not contain a claim for priority based on provisional application no. 60/400,072.

The un-executed declaration contained a claim for priority based on provisional application no. 60/400,072 filed on August 2, 2002, but the priority claim was improper since it was not included in the specification.

The instant petition was filed on September 20, 2005. The petition seeks to amend the specification by adding the language,

This application is a national stage of PCT/US03/23729, which was filed July 30, 2003, and claims the benefit of United States Provisional application 60/400,072, which was filed on August 2, 2002.

When an application is filed on or after November 29, 2000, benefit claims under 35 U.S.C. 119(e), 120, 121 and 365(c) must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. For the instant application, the above period of time ended on December 2, 2003. The priority claim at issue was not made by this date. However, petitioner has submitted a petition under 37 CFR 1.78(a)(6) which allows one to make late priority claims if certain criteria are satisfied.

Per 37 CFR 1.78(a)(6), a petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 37 CFR 1.78(a)(5)(i), unless previously submitted;
(2) The surcharge set forth in § 1.17(t); and
(3) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there

is a question whether the delay was unintentional.

Petitioner has failed to satisfy (1) above. The petition is not accompanied by a reference to the prior-filed application in:

- (1) a *proper* amendment to the first line of the specification following the title as required by 37 CFR 1.78(a)(5)(iii), or
- (2) an Application Data Sheet (ADS) in accordance with 37 CFR 1.76(b)(6).

The amendment submitted concurrently with the instant petition is not considered a proper reference under 37 CFR 1.78(a)(5). The amendment seeks to add language stating the application is a national stage application of a PCT application.

The application was not filed as a national stage of the PCT application.

A regular utility application cannot be converted to a national stage application after the filing of the application.

Although the application can technically be amended to claim continuity based on the PCT application, the Office notes the PCT application and the instant application were both filed on July 30, 2003. Therefore, petitioner may wish to consider whether or not a claim for priority based on the PCT application would bring any benefits.

Any request for reconsideration should be accompanied by a new amendment which does not refer to national stage status for the application. For example, a new amendment should include a statement such as, "This application claims the benefit of U.S. Provisional Application No. 60/---,--- filed ----."

Further correspondence with respect to this matter should be addressed as follows:

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